

REMARKS

Applicants submit that the amendments made herein are fully supported in the present specification as filed and add no new matter. Entry of the present amendment is respectfully requested.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Amendment be entered for purposes of an Appeal. The Amendment reduces the issues on appeal by reducing the number of claims and/or overcoming the rejections under 35 U.S.C. § 112, first paragraph. Thus, the issues on appeal would be reduced.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, all claims except claim 23 are canceled. Obviously, no new matter has been added with these changes.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Advisory Action and Previous Amendment

Applicants filed an Amendment after a Final Office Action on April 8, 2009. In response

to the April 8 Amendment, the Examiner issued an Advisory Action on May 8, 2009 indicated that the Amendment did not place the present application into condition for allowance since the enablement rejection (35 U.S.C. § 112, first paragraph) was not overcome. Thus, the previous Amendment of April 8 was not entered.

Substance of the Interview

Applicants thank the Examiner for the telephonic Interview of May 15, 2009 (Interview Summary dated May 21, 2009). The assistance of the Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicants submit the following remarks.

The Interview Summary form amply summarizes the discussions at the Interview. Applicants inquired as to whether or not the rejection under 35 U.S.C. § 112, second paragraph has been overcome, and for clarification regarding the rejection under 35 U.S.C. § 112, first paragraph. It is believed that the § 112, second paragraph has been overcome. Regarding the § 112, first paragraph rejection, the Examiner referred Applicants' representative to the Final Office Action at page 3 of the Office Action and reiterated the remarks thereon.

Issues under 35 U.S.C. § 112, First Paragraph

Claim 1 stands rejected as failing to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See Office Action, paragraph 3, page 2.

Further, claims 1, 3, 5, 24 and 25 stand rejected as failing to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See Office Action, paragraph 3, page 2.

Also, claims 26-28 stand rejected as failing to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See Office Action, paragraphs 4-5, pages 2-4.

Since the disputed claims, these rejections are rendered moot. Reconsideration and withdrawal of these rejections are respectfully requested.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 23-25 stand rejected as failing to comply with the requirements of the second paragraph of 35 U.S.C. § 112. See Office Action, page 6 (paragraph 6). Applicants respectfully traverse.

First, claims 24-25 have been canceled thereby rendering the rejection of these claims moot.

Second, regarding claim 23, Applicants respectfully refer the Examiner to the comments in the Advisory Action of May 8, 2009. The PTOL-303 form indicates that the enablement rejection has not been overcome (with reference to the previous Amendment filed on April 8, 2009). However, Applicants respectfully submit that the § 112, second paragraph has been overcome as this rejection was not maintained as stated in the Advisory Action, and it appears that the April 8 Amendment has overcome this rejection. For sake of convenience and completeness, the comments from the previous Amendment are repeated below.

Also, the Examiner is rejecting this claim due to the recitation of “substantially” in describing the pattern of Figure 3. Figure 3, also described in paragraph [0082] at page 27 of the original specification, refers to powder X-ray diffraction data.

However, the Examiner cites M.P.E.P. § 2173.05(b)(F) to support this rejection. While this section of the M.P.E.P. refers to terms such as “superior” and “aesthetically pleasing,” this M.P.E.P. subsection does not refer to the term “substantially.” Instead, M.P.E.P. § 2173.05(b)(D) refers to “substantially,” wherein some case law that holds this term to be definite. For instance, Applicants note *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975).

Furthermore, Applicants respectfully disagree with the Examiner’s rejection since U.S. case law establishes that “substantially” can be a part of the claim language if the term “serves reasonably to describe subject matter so that its scope would be understood by persons in field of invention, and to distinguish the claimed subject matter from the prior art,” and is “warranted by the nature of the invention, in order to accommodate minor variations that may be appropriate to secure the invention.” See *In re Mattison, supra*; *Verve LLC v. Crane Cams Inc.*, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002) (wherein the Federal Circuit found that the term “substantially” does not render the disputed patent claims invalid for indefiniteness, and remanded to the lower court).

Therefore, Applicants respectfully request reconsideration of claim 23 in its recitation of “substantially”, as such language does not render the claim as indefinite since one skilled in the art can determine the scope of the claimed invention in terms of a certain degree. As stated in *Verve LLC*, terms such as “substantially” are used in patents when warranted by the nature of invention in order to accommodate minor variations that may be appropriate to secure invention and may be necessary in order to provide an inventor with the full benefit of an invention. 65

USPQ2d at 1054. That is the case here given the strength of the peaks of the X-ray diffraction data.

Also, the understanding of the scope of “substantially” can be derived from sources outside the specification. As further support of Applicants’ position, Applicants refer the Examiner to the previously submitted excerpt (and English translation thereof) from Masakuni Matsuoka, “Advanced Technology, Application and Development of Polymorphic Crystals,” cover and p. 17 (August 2005) (3 pages total). As can be seen from Table 4 (page 17), X-ray diffraction data is sufficient in describing a polymorph. IR and solid state NMR can also identify polymorphic crystals. Thus, with Figure 3 being recited in the claim, the state of the art clearly guides the skilled artisan of the proper meaning of “substantially.”

In addition, Applicants note other case law that supports the claim language of, e.g., “substantially equal” and “closely approximate.” See *Andrew Corp. v. Gabriel Elecs. Inc.*, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988). As stated in *Andrew Corp.*, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention, and to distinguish the claimed subject matter from the prior art, the term “substantially equal” has been accepted in patent examination and upheld by the courts. 6 USPQ2d at 2012.

Finally, the USPTO has already accepted claim language like “substantially”. For instance, claim 1 of U.S. Patent No. 7,405,216 B2 uses the term “approximately” in describing X-ray powder diffraction data points.

Accordingly, it is respectfully submitted that the only pending claim in this application complies with the requirements of the second paragraph of 35 U.S.C. § 112. Reconsideration and withdrawal of this rejection are respectfully requested.

Application No. 10/571,279
Art Unit 1626
After Final Office Action of January 9, 2009

Docket No.: 1056-0133PUS1

Conclusion

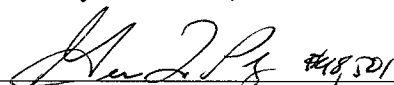
In view of the above amendment, Applicants believe the pending application is in condition for allowance. A Notice of Allowability is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 1, 2009

Respectfully submitted,

By  #48,501
✓ Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant